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| 09/628,423 | 07/28/2000 | Annie Audibert | 612.38836X00 | 2984 |

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| EXAMINER |
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TUCKER, PHILIP C

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| ART UNIT | PAPER NUMBER |
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1712

DATE MAILED: 02/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

T-D-4

Office Action Summary

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|-----------------|-----------|----------------|----------|
| Application No. | 628423 | Applicant(s) | AUDIBERT |
| Examiner | P. TUCKER | Group Art Unit | 1712 |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on _____.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 1 ~ 11 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1 ~ 11 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

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DETAILED ACTION

Claim Objections

1. Claims 4-6 are objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-6 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 and 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 7 teach “conventional ingredients” without specific definitions. Since drilling fluids may have a wide variety of ingredients, the scope of the claims are not clear.

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Claims 1, 2, 7 and 8 have "or an oil" or "an oil" in parenthesis. It is not clear if such forms a part of the claim or not.

Regarding claims 2 and 8, the word "particularly" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Furthermore, the term "or equivalent" without further definition lacks clarity, since it is not clear what such equivalents are.

In claim 3, thiols and polyalkoxides are not alcohols.

Regarding claim 7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). There is also no antecedent basis for "the porous formation" in the last line of the claim.

4. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd.

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App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 10 recites the broad recitation 24-30%, 28-34%, 20-26% 9-15% and 4-10%, and the claim also recites 27%, 31%, 23% 12% and 7% respectively which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1-3, 7-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al. (4802998).

Mueller teaches a drilling fluid which comprises esters according to the present invention added within similar amounts therein (see examples, abstract).

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7. Claims 1-3, 7,8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Carney et al. (4409108).

Carney teaches a well fluid which comprises esters according to the present invention added within similar amounts therein (see Tables, abstract).

8. Claims 1, 2, 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Peacock (3379708).

Peacock teaches a drilling fluid which comprises esters according to the present invention added within similar amounts therein (see column 2, lines 51-69, claim 1, abstract).

9. Claims 1-3, 7, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberg (3047493).

Rosenberg teaches a drilling fluid which comprises esters according to the present invention added within similar amounts therein (see claims).

10. Claims 1-3, 7-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (2271696).

Jones teaches a drilling fluid which comprises esters according to the present invention added within similar amounts therein (see Table II).

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11. Claims 1-3, 7-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Malchow Jr. (5807811).

Malchow teaches a drilling fluid which comprises esters A (1) or A (2) according to the present invention added within similar amounts therein (see column 25, lines 20-35, abstract).

12. Claims 1-3, 7, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al. (5441927).

Mueller teaches a drilling fluid which comprises esters according to the present invention added within similar amounts therein (see claims and column 12, lines 44-52).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. is 703-872-9311.

PCT-2381
February 11, 2002


PHILIP C. TUCKER
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